REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.

The Rejection Under 35 U.S.C. §102(e)

Claims 1-45 were rejected as being anticipated by Pollack, *et al.,* (U.S. Patent 6,505,236; hereafter "Pollack"). The Applicant respectfully traverses this rejection, and requests that this rejection be reconsidered and withdrawn.

More particularly, the Applicant submits that the rejection does not fulfill all of the requirements for an anticipation rejection as set forth in MPEP §2131, which states, in part:

> "A claim is anticipated only if each and every element as set fort in the claim is found, either expressly or inherently described, in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

For example, the method of **Claim 1** recites, in part, "receiving a request to send an email." The rejection asserts that Pollack teaches this recited feature by disclosing "a receiving portal to receive email" citing Pollack, col. 4, lines 4-6. However, while the receiving portal of Pollack may receive an electronic mail item from a sender, the receiving portal actually does not disclose receiving <u>a request</u> to send an email. Moreover, Pollack does not teach, nor does the rejection assert the receiving portal receives requests of any kind, let alone a request to send an email as claimed.

Claim 1 further recites, in part:

> determining whether a recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments, if the email to be sent includes one or more attachments.

The rejection asserts that Pollack teaches this recited feature by disclosing "a mail attachment storage system" (*see* Pollack, col.4, lines 25-34). However, such mail attachment storage system fails to support, either explicitly or implicitly, determining

whether a recipient of the email has distributed storage <u>separate</u> from an incoming mail server of the recipient, as claimed. Tellingly, Pollack is silent with regard to determining if the storage is separate from an incoming mail server <u>of the recipient</u> as claimed.

Claim 1 additionally recites, in part:

> determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage;
> determining whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address; and

Quite simply, Pollack fails to disclose either of the above-recited "determinings," as asserted by the Office Action. That is, the cited portions (col. 4, lines 34-39 and col. 6, lines 39-48) of Pollock are unrelated to determining a network address of the recipient's distributed storage and are further unrelated to determining whether the recipient's distributed storage is available. Instead, these portions of the reference describe...

The method of Claim 1 concludes by reciting, in part:

> servicing said request to send said email based at least in part on the results of said determinations.

The rejection asserts that the recited servicing of the request to send said email based at least in part on the results of said determinations is taught by Pollack in that Pollack "discloses an email sent without an attachment" (*see* Pollack, col. 7, lines 1-11). To the contrary, Pollack cannot service the request to send the email based at least in part on the results of the determinations, as claimed, because, as noted above, Pollack does not teach any determinations that can be acted upon.

Accordingly, for at least the reasons set forth above, the Applicant respectfully submits that Claim 1 is not anticipated by Pollack. Further, due to their dependency upon Claim 1, is it respectfully submitted that dependent Claims 2-12 are similarly distinguishable over Pollack.

Further still, it is submitted that the method of Claims 13-18, the method of Claims 23-27, the apparatus of Claims 28-34, the apparatus of Claims 35-37, and the apparatus of Claims 41-45 are distinguishable over Pollack for at least the same reasons set forth above regarding Claim 1. By such submission, the Applicant does not acquiesce, or otherwise imply, that Claims 13-18, 23-27, 28-34, 35-37, and 41-45 are of the same scope as Claims 1-12. Rather, the rejection merely states that such claims are rejected under the same rationale as Claims 1-12 and, under such rationale, the Applicant submits that Claims 13-18, 23-27. 28-34, and 35-37 are patentably distinguishable over Pollack only to the extent that the claims recite common features.

Further, Claim 19 recites, in part, the step of:

> receiving a registration to register an email user's distributed storage for email attachments.

The rejection asserts Pollack discloses this element at col. 4, lines 25-29:

> "In order to eliminate this potential bandwidth bottleneck, the network-based mail attachment storage system 10 includes an attachment stripper 24 for detaching attachment 20 from mail item 14, which generates stripped attachment 20'. Storage device 26 stores stripped attachment 20'."

However, this cited section of Pollack fails to disclose the element of an email user's distributed storage for email attachments, as claimed. More tellingly, Pollock fails to disclose both the registration to register the email user's distributed storage as well as the functionality for receiving the registration to register the email user's distributed storage.

Accordingly, for at least the reasons set forth above, the Applicant respectfully submits that Claim 19 is not anticipated by Pollack. Further, due to its dependency upon Claim 19, is it respectfully submitted that dependent Claim 20 is similarly distinguishable over Pollack.

Claim 21 recites, in part:

> receiving a request from a selected one of a sender
> and an incoming email server of a user to pull an
> attachment of an email;
> in response, submitting a request to the selected
> one of the sender and the incoming email server of the
> user to pull said attachment;
> receiving said email attachment; and
> storing said email attachment.

The rejection asserts that Pollack discloses all elements of Claim 21 at col. 5, lines 50–67, and col. 7, lines 1–11. Granted, Pollack does disclose "receiving a request from recipient 22 to download stored attachment 20'" (*see* Pollack, col. 5, lines 61–62). However, Pollock is silent with regard to receiving the request from a selected one of a sender and an incoming email server of a user, as claimed. Therefore, Pollack cannot act in response to receiving the request from a selected one of a sender and an incoming email server, and further cannot submit a request to the selected one of the sender and the incoming email server of the user to pull the attachment as claimed.

Moreover, Pollack discloses "receiving 102 from a sender an electronic mail item which contains a forwarding specification and an attachment" (*see* Pollack, col. 7, lines 1–2). However, this cited section of Pollack fails to disclose receiving a request from a selected one of a sender and an incoming email server of a user to pull an attachment of an email. Further, because this cited section of Pollack does not disclose a request, no response can be made to a request as claimed.

Accordingly, for at least the reasons set forth above, the Applicant respectfully submits that Claim 21 is not anticipated by Pollack. Further, due to its dependency upon Claim 21, is it respectfully submitted that dependent **Claim 22** is similarly distinguishable over Pollack.

Further still, it is submitted that the apparatus of **Claims 39–40** are distinguishable over Pollack for at least the same reasons set forth above regarding Claim 21. By such submission, the Applicant does not acquiesce, or otherwise imply, that Claims 39–40 are of the same scope as Claim 21–22. Rather, the rejection merely states that such claims are rejected under the same rationale as Claims 21–22 and,

under such rationale, the Applicant submits that Claims 39-40 are patentably distinguishable over Pollack, insofar as the claims recite common features.

Claim 38 recites, in part:

> storage medium having stored therein a plurality of programming instructions designed to enable said apparatus to
> receive a registration to register an email user's distributed storage for email attachments.

The rejection asserts Pollack discloses the above recited elements of Claim 38 at col.4, lines 25-39. The cited section of Pollock recites a "storage device 26." However, Pollack fails to disclose the storage device having stored therein a plurality of programming instructions. The lack of a plurality of programming instructions further prevents the storage device of Pollock from being designed to enable said apparatus to receive a registration to register an email user's distributed storage for email attachments, as recited in the claim above.

Additionally, Pollack does not disclose registering an email user's distributed storage for email attachments as is claimed. In contrast, Pollack discloses that the mail attachment storage system is only "network-based" (*see* Pollack, col. 4, line 26) and, more tellingly, Pollack is silent as to how the mail attachment storage system relates to the email user.

Claim 38 further recites, in part:

> store a network address of the email user's distributed storage for email attachments.

The rejection asserts Pollack discloses the recited feature at col. 4, lines 34-39. However, as discussed above, Pollack is silent with regard to both the email user and the email user's distributed storage. Therefore, it follows that Pollack cannot disclose that the network address of the email user's distributed storage is stored revealing a patentable distinction between Claim 38 and Pollock.

Accordingly, for at least the reasons set forth above, the Applicant respectfully submits that Claim 38 is not anticipated by Pollack.

As discussed above, it is submitted that Pollack does not anticipate the rejected claims under the requirements stated in MPEP §2131. Therefore, the Applicant further submits that the present rejection under 35 U.S.C. §102(b) be reconsidered and withdrawn.

Conclusion

The remaining references of record have been studied. It is respectfully submitted that they do not compensate for the deficiencies of the reference utilized to reject the pending claims.

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance. Early and forthright issuance of a Notice to that effect is earnestly solicited.

Respectfully submitted,

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